

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-13 and 15-43 are pending in the application. Claims 27-37 have been withdrawn for being directed to non-elected subject matter. Claim 14 is cancelled. See *Office Action* dated August 25, 2006, at p. 2. Claims 1-13, 15-26 and 38-43 stand rejected. No claim is amended by this response.

II. Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-13, 15-26 and 38-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. US 2003/0001108 A1 ("Rangwalla") in view of U.S. Patent No. 5,382,282 ("Pennaz"). The Examiner alleges that Rangwalla discloses a packaging material comprising a substrate, an ink print layer and a lacquer overcoat. *Office Action* at pp. 2-3. The Examiner contends that "it would have been obvious to a person of ordinary skill in the art to combine the ink composition taught by Pennaz with the invention of Rangwalla so as to provide a printed packaging material containing [an] ink composition having enhanced water stability and viscosity." *Id.* at p. 3.

The Examiner admits that Rangwalla fails to disclose the claimed ink composition of the present invention. *Office Action* at pp. 3-4. To remedy this deficiency, the Examiner relies upon Pennaz. *Id.* at p. 3. Pennaz allegedly teaches an electron beam curable ink composition. According to the Examiner, the "motivation for combining Rangwalla and Pennaz is the need for the use of [an] electron beam composition to be applied on a layered material." *Office Action* at p. 4. In support of this argument, the

Examiner has applied the doctrine of inherency. *Id.* The Examiner alleges that because “neither Rangwalla nor Pennaz expressly discloses that the ink does not bond with the lacquer, and both the ink and the lacquer are cured by the same method of curing, the ink inherently bonds with the lacquer.” *Id.* The Applicant respectfully disagrees, and traverses this rejection for at least the following reasons.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “A *prima facie* case of obviousness is established when teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). The teaching or suggestion to make the claimed combination must be found in the prior art itself, not the applicant’s disclosures. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

While “[t]he express, implicit, and inherent disclosures of a prior art reference may be relied upon in a rejection of claims under 35 U.S.C. § 102 or 103,” see M.P.E.P. § 2112, “[t]he mere fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original), citing *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981). The prior art references must “make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would so be recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.” *In re Robertson*, 169

F.3d 743, 745 (Fed. Cir. 1999). Therefore, in relying on a theory of inherency, the burden lies on the Examiner “to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office has failed to provide a factual basis to support the assertion that ink and lacquer bonding is an inherent characteristic of the prior art compositions taught and/or suggested by Rangwalla and Pennaz. The Examiner has failed to produce any factual evidence or technical reasoning to support the assertion that the combination of monomer-containing ink and lacquer layers would necessarily result in bonding between the two when cured. Instead, the Examiner relies on the absence of evidence to prove inherency by arguing that bonding between the two layers must exist because neither Rangwalla nor Pennaz explicitly disclose that bonding does not occur. *Office Action* at p. 4. In doing so, the Examiner has improperly shifted the burden to the Applicant to prove that lacquer and ink bonding is not inherent in the asserted combination teachings of Rangwalla and Pennaz.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness over the present claims, and Applicant respectfully requests withdrawal of the present rejection.

III. Conclusion

Applicant respectfully requests the entry of this Response under 37 C.F.R. § 1.113 and that claims 1-13, 15-26 and 38-43 be placed in condition for allowance. In the alternative, entry of this Response would allow the Applicants to reply to the new

arguments asserted in the final rejections. In addition, entry of the Response will place the application in better form for appeal, if the Examiner continues to dispute the allowability of the pending claims.

In view of the foregoing remarks, Applicant submits that the claimed invention is not obvious in view of the prior art references cited. Applicant therefore requests entry of this Response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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